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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/705,327	11/10/2003	Kiyoaki Mori	AA-547C	5111

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EXAMINER

VENKAT, JYOTHSNA A

ART UNIT	PAPER NUMBER
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1615

DATE MAILED: 04/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/705,327

Applicant(s)

MORI ET AL.

Examiner

JYOTHSNA A. VENKAT Ph. D

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 December 2004.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

J/L

DETAILED ACTION

Receipt is acknowledged of remarks filed on 12/20/04. Claims 1-11 are pending in the application and the status of the application is as follows:

Applicants are notified that due to an inadvertent typographical error the JP document submitted by applicants should be JP 61100514 instead of JP 002188044. The abstract has on the top the document as XP -002188044. This corresponds to JP 61100514. This error is regretted.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

3. Claims 1-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of U. S. patent 5,750,122 (122) and WO 00/61083('083) and JP 002188044 ('044 abstract).

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The instant application is claiming skin care composition and method of controlling sebum and method of making the composition comprising:

- (1) from about 0.01% to about 5% of a carboxylic acid/carboxylate copolymer;*
- (2) from about 0.1% to about 2% of a surfactant system comprising two or more nonionic surfactants selected from the group consisting of polyoxyalkylene alkyl ethers having a C12-18 alkyl substitute, polyoxyalkylene hydrogenated castor. oils, and linear or branched, mono- or tri-alkyl glycerides; from about 0.05% to about 5% of a silicone component;*
- (3) silicone component*
- (4) from about 0.01% to about 5% of an emollient oil;*
- (5) from about 0.1% to about 10% of a sebum absorbing agent (species is cellulose powder of claims 2-3);*
- (6) from about 1% to about 20% of a water soluble humectant; and*
- (7) an aqueous carrier;*
- (8) water soluble polymer (claim 4)*
- (9) tacky skin treatment agent(claim 5)*
- (10) sebum suppressing plant extract (claim 6)*
- (11) UV protecting agent (claim 7)*
- (12) whitening agent (claim 8)*

Patent '122 teaches compositions for treating skin or hair using ingredients 1, 3-4, and 6-12. The patent also teaches under example 21 anti-acne lotion. Anti-acne lotions are used to control excess sebum. Since excess sebum causes acne. See col.3, lines 15-35 fro panthenol

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which is ingredient 9, col.3, lines 40 et seq and col.4, lines 1-15 for ingredient 8, see col.4, lines 52-55 for ingredient 6, see also col.6, lines 40-54 for ingredient 6, see col.6, lines 55 et seq and cols.7 9 for ingredient 3, see col.6, lines 20-37 for ingredient 1, see col.col.9, line 44 for ingredient 12, line 49 for ingredient 11 and col.10, line 20 for ingredient 10 which is witch hazel extract. The patent does not teach specifically ingredient 2 and 4. However, WO '083 teaches micro emulsions using ingredients 2 at page 5 and page 6 , lines 1-9, oily component at page 6, page 7 lines 1-24. The WO document also teaches ingredient 8 along with humectants at page 9, lines 2035, page 10, and lines 1-9. The document also teaches actives at paragraph bridging pages 10-11, page 11, lines 10-30, pages 12-13 and at pages 15-16 teaches UV protecting agents in the compositions. The document at page 10 teaches the method of mixing the ingredients. The document or the patent does not teach cellulose powder in the compositions. The JP abstract teaches cellulose powder in cosmetic compositions.

Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to prepare compositions of the patent '122 and add the specific surfactant system and oily component along with UV protecting agents of WO document and add cellulose powder of the JP abstract expecting beneficial effect to the skin. One of ordinary skill in the art would be motivated to combine the ingredients since all the references are drawn to the cosmetic compositions and the idea of combining the ingredients flows logically from the art for having been used in the analogous cosmetic compositions. One of ordinary skill in the art would have reasonable expectation of success, since combining the surfactant system and oily component into the compositions of patent '122 has the advantage of providing the consumer moisturizing affect and imparting non-greasy feeling to the consumer and adding the cellulose powder to the

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composition has the additional advantage of providing to the compositions no coagulation effect caused by electric charge. Absent a showing side by side comparison of example 1 of WO document vs. example 21 vs. instant application composition claims giving unexpected and superior results commensurate with the scope of claims, the claims are rendered prima facie obvious over the combination of the references.

Response to Arguments

4. Applicant's arguments filed 12/20/04 have been fully considered but they are not persuasive.

5. Applicants argue that one important aspect of the compositions of the instant invention is shear thinning property which means that when "shear stress" is applied to the composition, for example, by rubbing onto the skin, the viscosity of the composition is significantly decreased and this results in "watery feel" and the carboxylic acid copolymer gives rise to this shear thinning property when the viscosity of the composition prior to applying "shear stress" is from about 100 to about 6,000 mPa·s.

6. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., applying shear stress) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

7. Applicants also argue that the compositions of the instant invention are drawn to transparent compositions and the compositions taught by patent '122 are drawn to emulsions and provide no indication of transparency.

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8. In response to the above argument, it is the position of the examiner that emulsions can also be transparent emulsions. Note that emulsions are formed when combining a water phase with an oily phase.

9. In conclusion one of ordinary skill in the art would certainly be motivated to combine the ingredients with a reasonable expectation of success that by adding surfactant system, oily component along with UV protect agents of WO document into the compositions of ' 122 has the advantage of providing the consumer moisturizing affect and imparting non-greasy feeling to the consumer and adding the cellulose powder to the composition has the additional advantage of providing to the compositions no coagulation effect caused by electric charge.

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

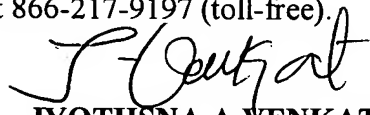
Any inquiry concerning this communication or earlier communications from the examiner should be directed to **JYOTHSNA A. VENKAT Ph. D** whose telephone number is

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571-272-0607. The examiner can normally be reached on Monday-Friday, 10:30-7:30: 1st Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, THURMAN K. PAGE can be reached on 571-272-0602. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


JYOTHSNA A VENKAT Ph. D
Primary Examiner
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